

REMARKS

In response to the Office Action mailed October 12, 2005, Applicants respectfully request reconsideration. To further the prosecution of this application, each of the issues raised in the Office Action is addressed herein.

Claims 1-113 formerly were pending in this application, of which claims 1, 15, 28, 36, 41 and 80 were independent claims. By this amendment, Applicants have amended claims 1, 15, 36, 41-43, 66, 79, 80 and 100, added new claims 114-117 and canceled claims 21, 38, 65 and 99, without prejudice. Applicants also have amended the specification. No new matter is added. Upon entry of this amendment, claims 1-20, 22-37, 39-64, 66-98 and 100-117 are now pending in this application, of which claims 1, 15, 28, 36 and 80 are independent claims. The application as now presented is believed to be in allowable condition.

A. Title

On page 2, the Office Action alleges that the title of the invention is not descriptive. Applicants respectfully disagree and believe that the original title of the application appropriately describes, in a general manner, the subject matter disclosed in the specification and presently claimed. In any case, in order to address any concerns the Examiner may have in this regard, Applicants amend the title to now read "Methods and apparatus for Generating a Prescribed Spectrum of Light." Applicants have not adopted the Examiner's suggested title of "Apparatus for Stimulating a Light Source Spectrum and Method," as at least independent claim 15 does not recite "simulation" or "light source." Similarly, independent claim 36 does not recite "light source."

B. Drawings

On page 3 of the Office Action, the drawings were objected to as allegedly failing to comply with 37 CFR 1.84(p)(4). Applicants respectfully disagree and suggest that the noted features (i.e., Planckian locus, line, and black body curve; conductive sleeve and conductive

aluminum sleeve; enclosure plate and disk-shaped enclosure plate) would be readily understood by one of ordinary skill in the art as unambiguously indicated in the specification and the drawings. However, in order to address the Examiner's concerns in this regard and move prosecution forward, Applicants have amended the specification to address the asserted inconsistencies in reference characters and/or terminology noted in the Office Action in connection with the drawings. In view of the amendments to the specification herein, it is believed that no drawing changes are necessary at this time.

C. Allowable Subject Matter

Applicants wish to thank the Examiner for recognizing the allowable subject matter of claims 28-35. In addition, the Examiner objected to claims 21, 38, 65-67, 79 and 99-101 as being dependent upon a rejected base claim, but stated the claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, while not acceding to the propriety of any rejections herein, but primarily to accelerate prosecution of the patent application, Applicants have amended some claims herein to accept subject matter deemed allowable by the Examiner.

For example, Applicants have amended claim 15 to recite the limitation of now canceled claim 21. Accordingly, claim 15 is allowable and allowance is respectfully requested. Claims 16-20 and 22-27 depend directly or indirectly from claim 15 and are allowable at least by dependency.

Applicants also have amended claim 36 to recite the limitation of now canceled claim 38. Accordingly, claim 36 is allowable and allowance is respectfully requested. Claims 37, 39 and 40 depend directly or indirectly from claim 36 and are allowable at least by dependency. Additionally, Applicants have amended claims 41-43 to depend from claim 36. Accordingly, claim 41-43 are allowable at least by dependency. New claims 114-117 depend from claim 43 and also are allowable at least by dependency. With regard to the subject matter of claims 41-43, as amended and new claims 114-117, no new matter is added. Applicants direct the Examiner's attention to page 20 of the specification and to the discussion of Fig. 6 in pages of the specification subsequent thereto.

Applicants also have amended claim 1 to recite the limitation of now canceled claim 65. More particularly, claim 1 now recites, among other things, *at least one sensor configured to measure at least one of the composite radiation produced by the apparatus and the sample radiation generated by the predetermined light source and provide at least one corresponding measurement signal to the controller.* Applicants note that the Examiner has indicated that no prior art was found teaching individually, or suggesting in combination, all of the features of Applicants' claim 1, specifically the controller controlling the plurality of illumination devices based on the sensor output. Based on the Examiner's reasons for indication of allowable subject matter, Applicants submit that claim 1, as amended, is allowable without incorporating the limitations of intervening claims 51 and 53. Accordingly, allowance of claim 1 is respectfully requested. Claim 66 is amended to depend from claim 53. Claim 79 is amended to remove redundant subject matter. Claims 2-14, 44-64 and 66-79 depend from claim 1 and are allowable at least by dependency.

Applicants also have amended claim 80 to recite the limitation of now canceled claim 99. More particularly, claim 80 now recites, among other things, *measuring at least one of the composite radiation and the sample radiation generated by the predetermined light source.* Based on the Examiner's reasons for indication of allowable subject matter, Applicants submit that claim 80, as amended, is allowable without incorporating the limitations of intervening claims 88 and 90. Accordingly, allowance of claim 80 is respectfully requested. Claim 100 is amended to depend from claim 90. Claims, 81-98 and 100-113 depend from claim 80 and are allowable at least by dependency.

D. Claim Rejections under 35 U.S.C. §103

Claims 1-3, 5, 9, 15, 19, 20, 22 and 80 were rejected under 35 U.S.C. §102(b) as being anticipated by Williams (U.S. Patent No. 2,686,866).

Claims 1-3, 5, 8, 9, 15, 19, 20, 23 and 80 were rejected under 35 U.S.C. §102(b) as being anticipated by Boenning et al. (U.S. Patent No. 3,760,174).

Claims 4, 6-8, 10-14, 16-18, 23-27, 36, 37, 39-64, 68-78, 81-98 and 102-113 were rejected under 35 U.S.C. §103(a) as being unpatentable over Williams.

Claims 4, 6, 7, 10-14, 16-18, 24-27, 36, 37, 39-64, 68-78 and 81-98 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boenning et al.

While Applicants disagree with the Examiner's contentions regarding Williams and Boenning et al., Applicants submit that the rejections are moot in light of the amendments to the claims as discussed in the above remarks. Accordingly, Applicants do not present detailed comments with respect to the Williams and Boenning et al. references at this time, though Applicants reserve the right to discuss the substantive merits of the rejections at a later time if deemed necessary.

In this regard, Applicants take this opportunity to specifically traverse the Examiner's assertions of inherency with relation to "simulating a desired spectrum corresponding to sample radiation generated by a predetermined light source" (pages 8 and 11 of the Office Action). As the Examiner knows, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, (Bd. Pat. App. & Inter. 1990) and MPEP § 2112(IV). The extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The Examiner alleges that "any combination of light sources would inherently produce a composite spectrum that would correspond to at least one of all known light sources." However, that is not what is recited in Applicants' claims. Applicants recite a *controller ... to produce composite radiation having at least one resulting spectrum that simulates a desired spectrum corresponding to sample radiation generated by a predetermined light source*. Thus, "any" combination of light sources does not produce composite radiation that simulates a desired spectrum. Further, the desired spectrum is one generated by a predetermined light source, and not "at least one of all known light sources", as stated by the Examiner. The Examiner has taken a broad generic statement regarding combinations of lights and erroneously applied it to the specific features recited in the claims. The Examiner has not provided a sound basis in fact or sound technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily

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flows from the teachings of the applied prior art. It does not logically follow from the Examiner's statement that a controller inherently can produce composite radiation that simulates a desired spectrum generated by a predetermined light source. Based on the above, Williams and/or Boenning et al. do not inherently teach or suggest a controller that simulates a desired spectrum of a predetermined light source.

CONCLUSION

It is respectfully believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment set forth in the Office Action does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Furthermore, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify any concession of unpatentability of the claim prior to its amendment.

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' representative at the telephone number indicated below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 06-1448, reference CKB-061.02.

Respectfully submitted,



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